

AUG 07 2007

Application No. 10/762,240
Reply To Non-Final Office Action dated June 19, 2007

Docket No.: 215407-106338

REMARKS

Claims 26-29 and 34-63 are currently pending. Previously-allowed claims 26-29, 34, 35, 46-51 and 58-63 are now rejected in the present Office Action. Claims 26-29 and 34-63 now stand rejected. Claims 26, 28, 29, 46, 48, 49, 52, 54 and 55 were amended to clarify the subject matter of the present invention. No new claims have been added in this paper. Favorable reconsideration is respectfully requested in light of the following remarks.

I. Double Patenting

The present application is related to co-pending application serial number 10/404,109 ("the '109 application"). The '109 application includes independent claim 27, which is generally directed to filter media having an EPDM seal including TPV particles embedded therein.

Although the '109 application is related to the present application, independent claims 26, 36, 46, 52 and 58 of the present invention each have specific limitations that are distinguishable from independent claim 27 of the '109 application. None of the pending claims in the present application recite filter media having an EPDM seal including TPV particles embedded therein. Applicant notes that independent claim 58 of the present invention recites a TPV seal, however, no mention is made in claim 58 of an EPDM material. After giving full consideration to the specific limitations recited in each of independent claims 26, 36, 46, 52 and 58 it will become apparent that a double-patenting rejection is not supported regarding the claimed subject matter recited in application serial number 10/404, 109. Withdrawal of the double-patenting rejection is respectfully requested.

II. Claim Rejections Under 35 USC § 103(a)

The Office Action rejected claims 26-29 and 34-63 under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 3,397,518 to Rogers ("Rogers") in view of U.S. 6,288,171 to Finerman. The rejection is respectfully traversed.

The Examiner has taken the position that the combination of Rogers and Finerman provide a filter media including an EPDM seal with TPV particles embedded therein. Claims 26-29 and 34-63 of the present invention do not recite filter media including an EPDM seal with TPV particles embedded therein. For at least this reason, the rejection to claims 26-29 and 34-63 should be withdrawn.

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III. Formal Matters

A. Rejection Of Previously-Allowed Claims 26-29, 34, 35, 46-51 and 58-63

As required by M.P.E.P. §706.04 (8th Ed. 5th Rev.), Applicant notes that the following form paragraph is noticeably absent in the present Office Action:

The indicated allowability of claim [1] is withdrawn in view of the newly discovered reference(s) to [2]. Rejection(s) based on the newly cited reference(s) follow.

Examiner Note

1. In bracket 2, insert the name(s) of the newly discovered reference.
2. Any action including this form paragraph requires the signature of a Primary Examiner. MPEP § 1004.

In addition, Applicant notes that M.P.E.P. §706.04 (8th Ed. 5th Rev.) requires that a "*claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action* (emphasis added)." In view of the above remarks and because the above form paragraph is absent in the present Office Action, Applicant finds no indication in the record that the Primary Examiner was consulted by Examiner Pham regarding the rejection of the previously allowed claims. Accordingly, responsive to this paper, Applicant requests that the present rejection of previously-allowed claims 26-29, 34, 35, 46-51 and 58-63 be thoroughly reviewed with the Primary Examiner associated with this matter and that an indication of the Primary Examiner's approval of this rejection be communicated to the Applicant.

B. Withdrawing Of Final Rejection

M.P.E.P. §706.07(c) (8th Ed. 5th Rev.) states that although "*it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious.*" For reasons established above in section II., it is respectfully submitted that the withdrawing of the Finality of the Office Action and re-opening of the prosecution of the claims was improper given the fact that the applied art in this Office Action (i.e., Rogers and Finerman) did not fully meet at least one claim because the claims of the present invention do not recite filter media including an EPDM seal with TPV particles embedded therein. Accordingly, responsive to this paper, Applicant requests that the withdrawal of the Finality of the previous Office Action and re-opening of the prosecution of the present application is thoroughly reviewed by the Primary Examiner.

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C. Examination And Rejection Of Independent Claims 26, 36, 46, 52 and 58

1. The present application recites five independent claims (i.e., claims 26, 36, 46, 52 and 58). In establishing a rejection of the claims, the Office Action indicates that Rogers discloses *"a filter element (5) having a side portion, a corner portion, 6 side portions, and a seal (4) of solid resilient thermoplastic (PVC being thermoplastic) (see col. 2, lines 54-56, col. 4, lines 45-47) disposed at corner sections and having bendable contact portion (8) extending from the face portion and formed of solid resilient material (4)."* Applicant respectfully submits that the above limitations are substantially similar to previously-cancelled claim 1 and that the above limitations are not found in any of independent claims 26, 36, 46, 52 and 58.

"A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." See M.P.E.P. §707.07(d) (8th Ed., Rev. 5). Thus, Applicant respectfully submits that the record *remains silent* with regard to the specific limitations recited in each of independent claims 26, 36, 46, 52 and 58 and that the Examiner has not established how one of, or, any permissible combination of the art of record anticipates or otherwise renders each of independent claims 26, 36, 46, 52 and 58 obvious. For at least this reason, Applicant requests withdrawal of the rejection to claims 26-29 and 34-63.

2. Applicant respectfully submits that it appears that Examiner Pham has rejected independent claims 26, 36, 46, 52 and 58 with the May 4, 2007 rejection of claims 27-32 of the '109 application; a simple side-by-side comparison of the rejection of the claims of the present Office Action with that of the May 4, 2007 Office Action leads one to this assumption. For example, at page 2, line 17 of the present Office Action, it is indicated that *"Claims 27-32 differ from the disclosure of Rogers in that the seal being thermoplastic vulcanized particles (TPV) embedded in ethylene-polyene terpolymer rubber (EPDM) [sic]."* It is respectfully submitted by the Applicant that *claims 30-32 of the present application are no longer pending* and that the above assertion is provided by Examiner Pham *with the exact same claim numbering* in the May 4, 2007 rejection of the '109 application.

Thus, in view of the appearance of the similarities of the rejection issued in the present Office Action with that in the '109 application, Applicant believes that full consideration of the specific limitations recited in independent claims 26, 36, 46, 52 and 58 was not provided. In addition to other reasons found throughout this paper in sub-sections II and III, Applicant requests withdrawal of the rejection to claims 26-29 and 34-63 for the above reasons.

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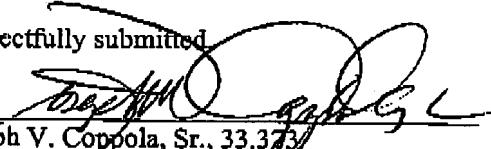
Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance of the application is earnestly solicited. However, if such allowance is not permitted Applicant requests that any subsequent action issued in the present case be marked non-final, for the reasons set forth above.

No fee is believed to be due with the filing of this paper; however, if any fees are due with the filing of this paper, please charge our Deposit Account No. 50-3145, under Order No. 215407-106338 from which the undersigned is authorized to draw.

Dated: August 6, 2007

Respectfully submitted

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